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18 IN THE UNITED STATES DISTRICT COURT
19 NORTHERN DISTRICT OF CALIFORNIA
20 SAN JOSE DIVISION

21 PHASE FORWARD INCORPORATED,)

22 CASE NO. C 05-4232 JF (HRL)

23 Plaintiff,

24 STIPULATION AND
25 [PROPOSED] ORDER
26 GRANTING LEAVE TO FILE
27 AMENDED COMPLAINT

28 v.

28 MARY NOEL ADAMS,

29 Defendant.

30 Plaintiff PHASE FORWARD INCORPORATED ("Plaintiff") and defendant

31 MARY NOEL ADAMS ("Adams"), by and through their respective counsel, hereby

32 stipulate as follows:

33 **RECITALS**

34 WHEREAS, Plaintiff filed this action on October 19, 2005, generally alleging
35 trademark infringement and trademark dilution by Adams of certain PHASE FORWARD
36 trademarks.

37

1 WHEREAS, at the time of filing, Plaintiff was informed and believed that Adams
2 was a sole proprietor doing business under the name "Phase Forward," and was the only
3 appropriate defendant in this lawsuit.

4 WHEREAS, on May 23, 2006, Plaintiff took the deposition of defendant Adams.
5 Adams testified that in approximately the beginning of 2004, she formed "Phase Forward
6 LLC," of which she is President and sole shareholder.

7 WHEREAS, Plaintiff desires to amend its complaint in this action to add Phase
8 Forward LLC as a defendant. Counsel to Adams has agreed to stipulate to the amendment,
9 and has advised that it will also serve as counsel to Phase Forward LLC.

10 **STIPULATION**

11 Phase Forward Incorporated and Mary Noel Adams, through their respective
12 counsel, stipulate and agree that pursuant to Federal Rules of Civil Procedure 15 and 21,
13 Phase Forward Incorporated may file an Amended Complaint, a copy of which is attached
14 hereto.

15 It is further stipulated that defendant Adams waives notice and service of the
16 Amended Complaint and shall be deemed served as of the date this stipulation is adopted
17 as an order of Court.

18 It is further stipulated that Phase Forward LLC waives formal service of the
19 summons and Amended Complaint, and is deemed served as of the date this stipulation is
20 adopted as an order of Court.

21 DATED: June 9, 2006

22 PHILLIPS, ERLEWINE & GIVEN LLP

23

24 By:

25 Spencer C. Martinez
26 Attorney for Plaintiff

27 19
28 DATED: June 9, 2006

29 Laura A. Thompson, Esq.
30 Attorney for Defendant
31 Mary Noel Adams

ORDER

Good cause appearing, IT IS SO ORDERED.

DATED: July 21, 2006

United States District Court Judge

DAVID M. GIVEN (State Bar No. 142375)
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Attorneys for Plaintiff

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

**PHASE FORWARD INCORPORATED, a
Delaware Corporation,**) **CASE NO. 05-4232 JF (HRL)**
Plaintiff)
v.)
**MARY NOEL ADAMS, individually and
d/b/a PHASE FORWARD, and PHASE
FORWARD LLC, a California Limited
Liability Company.**)
Defendants.)
Plaintiff)
v.)
AMENDED COMPLAINT FOR
TRADEMARK DILUTION,
TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION
JURY DEMAND

Plaintiff alleges:

THE PARTIES

1. Plaintiff PHASE FORWARD INCORPORATED is a Delaware corporation with a principal place of business located at 880 Winter Street, Waltham, Massachusetts 02451.

2. Upon information and belief, Defendant MARY NOEL ADAMS who is and/or was at times which are relevant hereto an individual and a sole proprietor doing business under the name PHASE FORWARD, with a principal home and office address of 1707 Baker Street, San Francisco, California 94115.

3. Upon information and belief, Defendant PHASE FORWARD LLC is a California Limited Liability Company with a principal office address of 1707 Baker Street, San Francisco, California 94115.

4. Upon information and belief, Defendant MARY NOEL ADAMS is the sole member and shareholder of Defendant PHASE FORWARD LLC.

NATURE OF ACTION

5. PLAINTIFF brings this action for Federal Trademark Infringement (15 U.S.C. § 1114), Federal Unfair Competition (15 U.S.C. § 1125(a)), Federal Trademark Dilution (15 U.S.C. § 1125(c)), State Trademark Infringement (Cal. Bus. & Prof. Code § 14335), State Trademark Dilution (Cal. Bus. & Prof. Code § 14330), State Statutory Unfair Competition (Cal. Bus. & Prof. Code § 17200 et seq.), Common Law Trademark Infringement and Unfair Competition, and judicial review of a final Trademark Trial and Appeal Board (“TTAB”) decision (5 U.S.C. §§ 701 et seq.; 15 U.S.C. §§ 1063, 1071(b)).

JURISDICTION AND VENUE

6. Subject matter jurisdiction before this Court is founded upon 5 U.S.C. § 701 (review of final agency action), 28 U.S.C. § 1331 (federal question) and 28 U.S.C. § 1338 (trademarks and unfair competition).

7. Venue in this Judicial District with respect to the claims set forth herein against DEFENDANTS is proper pursuant to 28 U.S.C. § 1331(b)(1) and (2). Defendant MARY NOEL ADAMS is subject to personal jurisdiction in this District as she resides in and does business in this District and has caused tortious injury in this District. Therefore,

1 Defendant MARY NOEL ADAMS resides in this Judicial District for purposes of 28 U.S.C. §
2 1391. Defendant PHASE FORWARD LLC is subject to personal jurisdiction in this District as
3 it does business in this District and has caused tortious injury in this District. Therefore,
4 Defendant PHASE FORWARD LLC resides in this Judicial District for purposes of 28 U.S.C.
5 § 1391.

6

7 **INTRODUCTION**

8 8. Defendant MARY NOEL ADAMS filed an Application to register the
9 mark PHASE FORWARD with the United States Patent and Trademark Office (“USPTO”) in
10 International Class 35 for “Consultation services in the fields of product management,
11 marketing and business planning,” under Serial No. 78/169,672, filed October 1, 2002 with an
12 alleged first use in commerce of September 20, 2002.

13 9. PLAINTIFF, the U.S. registered mark holder for the mark PHASE
14 FORWARD, sent a cease-and-desist letter on February 26, 2003 to Defendant MARY NOEL
15 ADAMS requesting that she refrain from further use of PLAINTIFF’s registered trademark.

16 10. Defendant MARY NOEL ADAMS refused to cease and desist and an
17 Application was published in the Official Gazette (Trademarks) for Opposition on May 13,
18 2003 at Page TM 472. PLAINTIFF filed a Pre-Publication Letter of Protest on February 26,
19 2003 and a Notice of Opposition on June 23, 2003.

20 11. On August 23, 2005, after completing its Opposition procedure, the
21 TTAB rendered its Final Decision on the merits. A copy of the decision is attached hereto as
22 Exhibit “A”.

23

24 **PLAINTIFF’S RIGHTS IN THE PHASE FORWARD MARKS**

25 12. PLAINTIFF owns the following PHASE FORWARD trademarks
26 (hereinafter collectively, the “PFI Marks”) which have been registered with the USPTO:
27
28

- a. PHASE FORWARD (word mark)-Reg. No. 2,366,760,
Registered 7/11/00 (date of first use in commerce-12/14/98);
- b. PF PHASE FORWARD (design mark)-Reg. No. 2,580,055,
Registered 6/11/00, (date of first use in commerce-8/1 5/00); and
- c. PF PHASE FORWARD (design mark)-Reg. No. 2,599,003,
Registered 7/23/02, (date of first use in commerce-5/00/0 1).

13. PLAINTIFF's PHASE FORWARD family of marks also include registrations in two (2) additional countries and the European Union:

- a. PHASE FORWARD (word mark)-Japan-Reg. No. 4,655,385, Registered March 20, 2003;
- b. PHASE FORWARD (word mark)-Australia-Reg. No. 902845, Registered February 8, 2002; and
- c. PHASE FORWARD (word mark)-Community Trademark-Reg. No. 001821578, Registered August 20, 2002.

14. PLAINTIFF's registered PFI Marks are for "Computer software used in the management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom" (Reg. No. 2,366,760 and 2,599,003) and "Clinical data collection in the field of clinical and medical trial management and management services related to human clinical trials" (Reg. No. 2,580,055).

15. Additionally, PLAINTIFF uses the PHASE FORWARD trademark and brand name in association with its other goods, including the marks INFORM, INFORM UNPLUGGED, CLINTRACE, CLINTRIAL and INFORM ARCHITECT (software for electronic date management for clinical trials), and services, including the mark INPHASE (support services for PLAINTIFF's software).

1 16. As of December 14, 1998, PLAINTIFF commenced bona fide use of its
2 PHASE FORWARD mark on its goods and services distributed and sold in U.S. commerce.
3 PLAINTIFF's use of PHASE FORWARD on its goods and services has been valid and
4 continuous since at least that date.
5

6 **DEFENDANT'S APPLICATION AND USE OF HER/ITS MARK**

7 17. Defendant MARY NOEL ADAMS first adopted the mark PHASE
8 FORWARD on August 12, 2002.

9 18. Defendant MARY NOEL ADAMS has been doing business as PHASE
10 FORWARD since October 1, 2002.

11 19. Defendant PHASE FORWARD LLC has been doing business since at
12 least as early as the beginning of 2004.
13

14 **PLAINTIFF'S BUSINESS AND CUSTOMERS**

15 20. PLAINTIFF is currently qualified as a foreign corporation doing
16 business in Arizona, California, Delaware, Georgia, Indiana, Massachusetts, Michigan, New
17 Jersey, Pennsylvania and Washington, with offices in Kirkland, WA; Chicago, IL; Waltham,
18 MA ~headquarters); Everleigh, Australia; Maidenhead, U.K.; Paris, France; and Tokyo, Japan.

19 21. PLAINTIFF conducts business in the fields of developing and marketing
20 computer software and services used in pharmaceutical/biomedical clinical trials for electronic
21 data capture, data management and adverse event reporting, including such products as:
22 INFORM UNPLUGGED (wireless data entry software in clinical trials); CLINTRIAL (clinical
23 data management software); InForm (electronic data capture software); as well as related
24 services including training, installation and implementation) PFI software and consultation
25 work such as "advice in integrating the products into their other systems" and advice as to how
26 PFI products would work within their systems.
27
28

22. PLAINTIFF's clients include healthcare industry companies such as pharmaceutical and biomedical companies, clinical research organizations, and hospitals ~and universities.

DEFENDANTS' BUSINESS AND CUSTOMERS

23. DEFENDANTS currently conduct business in Walnut Creek, Mill Valley and San Francisco, California, Philadelphia, Pennsylvania, Dallas, Texas and Denver, Colorado and is also promoting the PHASE FORWARD mark throughout the United States.

24. DEFENDANTS also conduct business and advertisement via electronic media, the Internet, which reaches the entire country and the world.

25. DEFENDANTS conduct business in the fields of product management, marketing and business planning and has performed projects including: developing Wi-Fi strategies for Blue Mug (Berkeley, California software company) for wireless software service to run on handhelds and wireless phones; and development/marketing of consumer electronic devices similar to a laptop for use in PDAs and mobile phones accessing wireless networks.

26. DEFENDANTS have expressed an interest to team up with a health care consultancy and do wireless applications for them. Such applications included discussion as to equipping hospitals with wireless infrastructure which allows use of PDAs and the ability to perform electronic data capture.

27. DEFENDANTS proposed ideas to companies such as Blue Mug to introduce products and services to the health care market, such as PDAs and other wireless applications.

28. DEFENDANTS' clients include Blue Mug (developer of software for mobile devices); Microsoft Corporation (software company); and Leukemia and Lymphoma Society (voluntary health organization dedicated to funding cancer research, education and patient services).

SIMILAR BUSINESS AND CUSTOMERS

29. DEFENDANTS and PLAINTIFF each offer consulting services to companies involved in the pharmaceutical, biomedical and healthcare industry. They are both involved with and have clients in the wireless software and wireless services industries and assist in consulting and business planning functions.

PLAINTIFF'S OTHER INTELLECTUAL PROPERTY

30. PLAINTIFF is the owner and legal user of the domain name
www.phaseforward.com and has owned that domain name since as early as June 20, 1997.

31. PLAINTIFF is also the owner and legal user of domain names www.phaseforward.biz and www.phaseforward.org and has owned each domain name since as early as September 13, 2002.

DISPUTED INTELLECTUAL PROPERTY

32. Defendant MARY NOEL ADAMS is currently the owner and user of the domain name www.phaseforward.net and has owned the domain name since August 22, 2002.

33. A domain name dispute regarding the domain www.phaseforward.net was filed with the National Arbitration Forum on July 3, 2003 by PLAINTIFF against Defendant MARY NOEL ADAMS. A Notice of Decision was rendered on September 3, 2003 in which the Complaint was dismissed without prejudice as a result of the then pending TTAB Action.

DEFENDANT MARY NOEL ADAMS'S EFFORTS TO REGISTER PHASE FORWARD

34. Prior to Application for the PHASE FORWARD mark, Defendant MARY NOEL ADAMS conducted a web-search of the USPTO database and determined that PLAINTIFF's PHASE FORWARD mark had already been registered and was in use.

35. Defendant MARY NOEL ADAMS never received an opinion from any attorney regarding usage of the mark.

1 **PLAINTIFF'S ATTEMPTS TO PROTECT ITS INTELLECTUAL PROPERTY**

2 36. PLAINTIFF vigorously fights to protect the good name and reputation of
3 its marks and has sent cease-and-desist letters to unauthorized users of its marks.

4 37. PLAINTIFF subscribes to a Watch Notice Service to monitor the
5 Applications for marks similar to PLAINTIFF's including PHASE FORWARD to protect
6 PLAINTIFF's marks.

7 **COUNT I**

8 **FEDERAL TRADEMARK INFRINGEMENT (15 U.S.C. § 1114)**

9 38. PLAINTIFF incorporates by reference into Count I all allegations
10 contained in paragraphs 1 through 37 of this Complaint as though set forth fully herein.

11 39. DEFENDANTS have adopted and are using in interstate commerce in
12 connection with its goods and services the PHASE FORWARD mark including, but not limited
13 to, use of an Internet domain name identical to the PFI Marks. DEFENDANTS' use of the
14 PHASE FORWARD mark is likely to cause confusion, mistake and deception among
15 purchasers, potential purchasers and the relevant public as to source or sponsorship of
16 DEFENDANTS' products and/or their affiliation with PLAINTIFF. Such uses have and are
17 likely to cause damage to PLAINTIFF's business reputation and goodwill, and are further
18 likely to impede PLAINTIFF's ability to use its marks effectively.

19 40. DEFENDANTS' activities have been willful, knowing, deliberate,
20 malicious and intentional, causing a likelihood of confusion. DEFENDANTS' actions were
21 further done with the intent to trade upon the goodwill and reputation of PHASE FORWARD
22 and the PFI Marks.

23 41. PLAINTIFF's business, goodwill, and reputation have been and will
24 continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANTS
25 are enjoined.

1 42. PLAINTIFF's remedy at law is inadequate.

2 43. DEFENDANTS' actions constitute trademark infringement in violation
3 of 15 U.S.C. § 1114.

4 WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.
5

6 **COUNT II**

7 **FEDERAL UNFAIR COMPETITION (15 U.S.C. § 1125(A))**

8 44. PLAINTIFF incorporates by reference into Count II all allegations
9 contained in paragraphs 1 through 43 of this Complaint as though set forth fully herein.

10 45. DEFENDANTS have adopted and are using in interstate commerce a
11 PHASE FORWARD mark, as an Internet domain name and otherwise, identical to the PFI
12 Marks. DEFENDANTS' PHASE FORWARD mark is being used to assist in the sale of
13 DEFENDANTS' products, in a manner likely to cause confusion or mistake among consumers
14 in the marketplace. Such uses are likely to cause damage to the PLAINTIFF's business
15 reputation and goodwill, and are further likely to impede PLAINTIFF's ability to use its PFI
16 Marks effectively.

17 46. DEFENDANTS' use of marks identical to the PFI Marks constitutes use
18 in commerce of a mark that is likely to cause confusion or mistake among consumers.
19 Additionally, DEFENDANTS' use of such marks is likely to deceive consumers into believing
20 that DEFENDANTS are somehow affiliated, connected, or associated with PLAINTIFF, or that
21 PLAINTIFF sponsors or approves of DEFENDANTS' products or services.

22 47. DEFENDANTS' activities as alleged herein impede the ability of
23 PLAINTIFF to utilize the PFI Marks in a way that is beneficial to PLAINTIFF, and thereby
24 have allowed the DEFENDANTS to compete unfairly with PLAINTIFF.

25 48. DEFENDANTS' activities have been willful, knowing, deliberate,
26 malicious and intentional, causing a likelihood of confusion. DEFENDANTS' actions were

1 further done with the intent to trade upon the goodwill and reputation of PLAINTIFF and the
2 PFI Marks.

3 49. PLAINTIFF's business, goodwill, and reputation have been and will
4 continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANT
5 are enjoined.

6 50. PLAINTIFF's remedy at law is inadequate.

7 51. DEFENDANTS' activities constitute unfair competition in violation of
8 15 U.S.C. § 1125(a).

9
10 WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

11
12 **COUNT III**

13
14 **FEDERAL TRADEMARK DILUTION (15 U.S.C. § 1125(C))**

15 52. PLAINTIFF incorporates by reference into Count III all allegations
16 contained in paragraphs 1 through 51 of this Complaint as though set forth fully herein.

17 53. The PFI Marks have, through extensive and widespread use by
18 PLAINTIFF, become sufficiently distinct and well known by the public so as to be considered
19 "famous" for purposes of the Federal Lanham Act, 15 U.S.C. § 1125(c).

20 54. DEFENDANTS' activities, including use in interstate commerce of a
21 mark identical to the PFI Marks, has caused and will continue to cause dilution of the
22 distinctive quality of the PFI Marks, in violation of 15 U.S.C. § 1125(c).

23 55. DEFENDANTS' conduct complained of herein was done willfully,
24 knowingly, deliberately, maliciously and intentionally, with full knowledge of its capability to
25 dilute the distinctive quality of the PFI Marks, and with the specific intent to trade on
26 PLAINTIFF's reputation and to dilute the distinctive quality of the PFI Marks.

56. PLAINTIFF's business, goodwill and reputation have been and will continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANTS are enjoined.

57. PLAINTIFF's remedy at law is inadequate.

58. DEFENDANTS' activities constitute dilution in violation of 15 U.S.C. § 1125(c).

WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

COUNT IV

CALIFORNIA STATE STATUTORY TRADEMARK INFRINGEMENT
(CAL. BUS. & PROF. CODE § 14335)

59. PLAINTIFF incorporates by reference into Count IV all allegations contained in paragraphs 1 through 58 of this Complaint as though set forth fully herein.

60. DEFENDANTS' acts constitute infringement pursuant to California Business & Professions Code § 14335.

61. PLAINTIFF has been damaged and will continue to be damaged by DEFENDANTS' infringement.

62. PLAINTIFF's business, goodwill, and reputation have been and will continue to be irreparably harmed by DEFENDANTS' activities unless DEFENDANTS are enjoined.

63. PLAINTIFF's remedy at law is inadequate.

64. DEFENDANTS' actions constitute state trademark infringement in violation of California Business & Professions Code § 14335.

WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

COUNT V

CALIFORNIA STATE TRADEMARK DILUTION
(CAL. BUS. & PROF. CODE § 14330)

65. PLAINTIFF incorporates by reference into Count V all allegations contained in paragraphs 1 through 64 of this Complaint as though set forth fully herein.

66. The PFI Marks have, through extensive and widespread use by PLAINTIFF, become sufficiently distinct and well known by the public so as to be considered "famous" for purposes of California Business & Professions Code § 14330.

67. DEFENDANTS' activities, specifically including use of a mark identical to the PFI Marks, have caused and will continue to cause dilution of the distinctive quality of the PFI Marks, in violation of California Business & Professions Code §

68. PLAINTIFF's business, goodwill and reputation have been and will continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANTS are enjoined.

69. PLAINTIFF's remedy at law is inadequate.

70. DEFENDANTS' activities constitute dilution in violation of California Business & Professions Code § 14330.

WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

COUNT VI

**CALIFORNIA STATE UNFAIR COMPETITION
(CAL. BUS. & PROF. CODES § 17200 et seq.)**

71. PLAINTIFF incorporates by reference into Count VI all allegations contained in paragraphs 1 through 70 of this Complaint as though set forth fully herein.

72. DEFENDANTS' adoption and use of the PHASE FORWARD mark constitutes an unlawful, unfair, and fraudulent business practices and misleading advertising in violation of California Business & Professions Code § 17200 et seq.

73. PLAINTIFF has been damaged and will continue to be damaged by DEFENDANTS' unlawful, unfair, and fraudulent business practices and misleading advertising as alleged herein.

74. PLAINTIFF's business, goodwill, and reputation have been and will continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANTS are enjoined.

WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

COUNT VII

**CALIFORNIA COMMON LAW TRADEMARK
INFRINGEMENT AND UNFAIR COMPETITION**

75. PLAINTIFF incorporates by reference into Count VII all allegations contained in paragraphs 1 through 74 of this Complaint as though set forth fully herein.

76. PLAINTIFF owns common law trademark rights in the PFI Marks by virtue of its use of the marks in connection with its goods and services detailed above since December 14, 1998.

77. DEFENDANTS' acts alleged herein constitute common law trademark infringement and unfair competition under California common law.

78. PLAINTIFF has been damaged and will continue to be damaged by DEFENDANTS' trademark infringement and unfair competition.

79. PLAINTIFF's business, goodwill, and reputation have been and will continue to be irreparably harmed by the DEFENDANTS' activities unless the DEFENDANTS are enjoined.

WHEREFORE, PLAINTIFF prays for judgment as hereinafter set forth.

COUNT VIII

**REQUEST FOR JUDICIAL REVIEW OF TRADEMARK TRIAL AND APPEAL
BOARD DECISION (5 U.S.C. § 701 ET SEQ; 15 U.S.C. §§ 1063, 1071(b))**

80. PLAINTIFF incorporates by reference into Count VIII all allegations contained in paragraphs 1 through 79 of this Complaint as though set forth fully herein.

81. As the TTAB has issued a Final Decision denying PLAINTIFF's opposition to Defendant MARY NOEL ADAMS'S Trademark Application, PLAINTIFF respectfully requests de novo judicial review of the decision under the Administrative Procedures Act and the Lanham Act.

82. Defendant MARY NOEL ADAMS'S mark is identical to PLAINTIFF's PFI Marks and is likely to cause confusion, mistake and/or deception as to the source and/or origin of Defendant MARY NOEL ADAMS'S goods and services, thereby irreparably damaging PLAINTIFF and PLAINTIFF's goodwill in the PFI Marks.

83. Defendant MARY NOEL ADAMS'S registration of her mark is further likely to cause the public to assume erroneously that Defendant MARY NOEL ADAMS'S goods and services are sponsored by PLAINTIFF or that they are in some way connected with PLAINTIFF, thereby irreparably damaging PLAINTIFF and PLAINTIFF's goodwill in the PFI Marks.

84. Permitting Defendant MARY NOEL ADAMS'S application to register its mark in the USPTO, as ordered by the TTAB, will irreparably damage PLAINTIFF and PLAINTIFF's goodwill in the PFI Marks.

85. For the reasons stated herein, the Court should order that Defendant MARY NOEL ADAMS'S United States Trademark Application Number 78/169,672 be denied registration in the USPTO.

PRAYER FOR RELIEF

WHEREFORE, PLAINTIFF respectfully requests that the Court:

A. Declare that DEFENDANTS' unauthorized conduct violates PLAINTIFF's rights under the federal Lanham Act, California Business & Professions Code, and California common law.

B. Permanently enjoin DEFENDANTS, their officers, directors, agents, servants, employees, representatives, attorneys, related companies, successors, assigns, and all others in active concert or participation with them from:

1. Infringing PLAINTIFF's PFI Marks in any manner and from continuing to use any of the PFI Marks or any other confusingly similar trademark and/or designation including, but not limited to, an identical or confusingly similar Internet domain name, in connection with any goods or services or the sale, distribution, advertising, labeling or packaging of any goods or services;

2. Engaging in any conduct which falsely tends to represent or is likely to confuse, mislead or deceive vendors, consumers and/or members of the public into thinking that DEFENDANTS are affiliated with PLAINTIFF or that DEFENDANTS' goods or services are offered by PLAINTIFF and/or that DEFENDANTS' goods or services have been sponsored, approved or licensed by PLAINTIFF;

3. Engaging in any conduct tending to cause injury to the business and/or reputation of PLAINTIFF and to dilute the distinctive quality of PLAINTIFF's PFI Marks; and

4. Otherwise unfairly competing with PLAINTIFF.

C. Order DEFENDANTS to deliver to PLAINTIFF all documents, goods and materials in its possession bearing any trademark or designation which is confusingly similar or substantially identical to PLAINTIFF's PEI Marks.

D. Award profits to PLAINTIFF and assess against DEFENDANTS damages (including PLAINTIFF's lost profits) in an amount to be determined at trial and trebling such damages under the circumstances of this case;

E. Award to PLAINTIFF and assess against DEFENDANTS punitive or exemplary damages;

F. Award to PLAINTIFF and assessing against DEFENDANTS the costs, expert witness fees, and reasonable attorneys' fees incurred in connection with this action under applicable law;

G. Order the Director of the USPTO to deny registration of Defendant MARY NOEL ADAMS'S U.S. Trademark Application Number 78/169,672; and

H. Grant PLAINTIFF such additional, other, or further relief as the Court deems proper and just.

Dated: **PHILLIPS, ERLEWINE & GIVEN LLP**

PHILLIPS, ERLEWINE & GIVEN LLP

By:

Spencer C. Martinez
Attorney for Plaintiff

JURY DEMAND

PLAINTIFF demands trial by jury.

Dated: **PHILLIPS, ERLEWIN & GIVEN LLP**

By:

Spencer C. Martinez
Attorney for Plaintiff

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
August 23, 2005
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Phase Forward Incorporated

v.

Mary Noel Adams

Opposition No. 91156778
to Serial No. 78169672

David J. Shannon and M. Kelly Tillery of Leonard Tillery & Sciolla, LLP for Phase Forward Incorporated.

Matthew W. Stavish of Liniak Berenato & White, LLC for Mary Noel Adams.

Before Seeherman, Bucher and Grendel, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Mary Noel Adams seeks registration on the Principal Register of the mark PHASE FORWARD (standard character drawing) for services recited in the application as "consultation services in the fields of product management, marketing and business planning," in International Class 35.¹

Registration has been opposed by Phase Forward Incorporated. As its grounds for opposition, opposer

¹ Application Serial No. 78169672 was filed on October 1, 2002 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as September 20, 2002.

EXHIBIT A

Opposition No. 91156778

asserts that applicant's mark when used in connection with applicant's services so resembles opposer's previously used and registered marks, as well as its "family" of marks, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, and furthermore, that should applicant be issued a registration, it is likely to injure opposer's business reputation and dilute the distinctive quality of opposer's famous trade name and registered marks under Section 43(c) of the Trademark Act.

Applicant, in her answer, has denied the salient allegations in the opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer has also made of record its pleaded registrations by submitting certified status and title copies of the following three registrations:

REGISTRATION No. 2366760 **PHASE FORWARD** (STANDARD CHARACTER DRAWING)
for "computer software used in the management of clinical trials
of pharmaceutical products and medical devices and management
of data resulting therefrom" in International Class 9;²

² Registration No. 2366760 issued on July 11, 2000 claiming first use anywhere at least as early as June 3, 1997 and first use in commerce at least as early as December 14, 1998.

Opposition No. 91156778

REGISTRATION NO. 2580055



for "clinical data collection in the field of clinical and medical trial management and management services related to human clinical trials" in International Class 42;³ and

REGISTRATION NO. 2599003



for "computer software used in the management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom" in International Class 9.⁴

Opposer has also made of record, pursuant to a notice of reliance, applicant's responses to opposer's first set of interrogatories; the discovery deposition, with the relevant exhibits, of Mary Noel Adams, the applicant herein; and a decision by the National Arbitration Forum in a domain name dispute involving the parties herein.

The parties have fully briefed the case, but an oral hearing was not requested.

Preliminary matters

Opposer also submitted a number of additional materials under its notice of reliance. However, for various reasons, these materials cannot be made of record in this fashion,

³ Registration No. 2580055 issued on June 11, 2002 claiming first use anywhere and first use in commerce at least as early as August 15, 2000.

⁴ Registration No. 2599003 issued on July 23, 2002 claiming first use anywhere and first use in commerce at least as early as May 2001.

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and therefore they have not been considered. They include opposer's own responses to applicant's first set of interrogatories. Under the circumstances of this case (where applicant has submitted no evidence during its testimony period), an answer to an interrogatory may be submitted and made part of the record by only the inquiring party. 37 CFR §2.120(j)(3)(i)(5). Similarly, opposer may not rely on the discovery deposition of its own corporate counsel, which was taken by applicant. 37 CFR §2.120(j)(1).

Opposer submitted the pleadings from a domain name dispute between the parties, but these documents do not qualify as official records under 37 CFR §2.122(e). As to the affidavits of Christopher D. Olsyk, Jr., and Lynette H. Rezac, affidavits cannot be submitted unless the parties have stipulated to this, and no such stipulations have been filed. 37 CFR §2.123(b). Furthermore, as to the results of Mr. Olsyk's Internet search, printouts from Internet web searches cannot be submitted by a notice of reliance as they do not qualify as printed publications under 37 CFR §2.122(e). See In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999). See also Racioppi v. Apogee Inc., 47 USPQ2d 1368 (TTAB 1998) and TBMP Section 708. Finally, correspondence between opposer's counsel and applicant's counsel does not fall within any of the enumerated

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categories of evidence appropriately submitted under a notice of reliance.

The Facts

Because so much of the material submitted by opposer was not properly made of record, the only information we have about opposer is that it is the owner of its three pleaded registrations and, because Ms. Adams testified in her discovery deposition that she visited opposer's website, we know that opposer has a website.

Applicant adopted the mark PHASE FORWARD during August 2002 and has been in the consulting business as a sole proprietor since October 2002. Applicant conducts her business primarily in California, but promotes her mark, *inter alia*, in Illinois, Maryland and Texas. Applicant's response to Interrogatory No. 2. Applicant also advertises and conducts business over the Internet. Adams Deposition, pp. 33-35. Consistent with the recital of services in the involved application, the evidence of record demonstrates that applicant provides consultation services in the fields of product management, marketing and business planning. In conjunction with Blue Mug, a Berkeley, California software company, applicant has strategized about the ways in which health care facilities would develop wireless software

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applications to run on handheld devices and wireless phones. Moreover, applicant has expressed her interest in teaming up with a health care consultancy firm to equip hospitals with a "Wireless Fidelity" (Wi-Fi) infrastructure, allowing the use of personal digital assistants (PDAs) for tasks such as electronic data capture. In correspondence of record, she listed nurses, doctors, administration and other healthcare staff as potential users of these wireless software, devices and services. Adams Deposition, pp. 63-93, Bates Nos. Adams 214, 217, 204, 405-408, and 484. Applicant testified that in 2003 her website did list as clients or partners entities such as McKesson Corporation (provider of healthcare supply, information and care management products) and Aether Systems (mobile and wireless data solution provider).

Our Analysis

• Standing

As a preliminary matter, we find that opposer has established its standing in view of its registrations of the term PHASE FORWARD.

• Priority

Because opposer has made of record valid and subsisting registrations of its pleaded registrations, the issue of priority does not arise. See *King Candy Company v. Eunice*

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King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

• Likelihood of Confusion

We turn then to the issue of likelihood of confusion.

Although opposer has pleaded ownership of a family of marks in its notice of opposition, and has referred to such a family throughout its briefs, opposer has not demonstrated that it has promoted any of its marks together, such that they would be considered a family. See J & J Snackfoods Corp. v. McDonald's Corp., 932 F.2d 1360, 18 USPQ2d 1889 (Fed. Cir. 1991). Therefore, we must determine the issue of likelihood of confusion with respect to the three individual marks that are the subject of opposer's registrations.

Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the

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services and/or goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn then to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. In this case, as to opposer's first cited registration, the marks of the parties are identical in sound and appearance.

As to opposer's two design marks, the literal elements are identical to applicant's mark as to sound, and as to appearance, they are substantially the same as applicant's mark. Although opposer's design marks also contains a "PF" design, it is the PHASE FORWARD portion that is the dominant element of these marks, since consumers will call for opposer's goods and services using this term. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

Although we have compared the marks in their entireties, we have thus accorded greater weight to the PHASE FORWARD portion of opposer's registered marks. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) [in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing

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improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests upon a consideration of the marks in their entireties].

However, despite the fact that the term PHASE FORWARD is the same in both marks, because of the goods and services with which the respective marks are used, they have connotative differences. With respect to opposer's goods and services, the term "phase" suggests a connection with FDA processes, such as "Phase II clinical trials." For applicant's mark, applicant's website shows a presentation topic known as "New Product Development - Phase 0: Ideation and Concept Generation." Accordingly, prospective customers are likely to view the word "phase" in opposer's mark as suggestive of a "phase" of clinical trials, while applicant's usage may be suggestive generally of a discrete piece of a consultation service project. Thus, while the parties' marks are identical in sound and nearly identical in appearance, because of the differences in connotation we cannot say that they convey the same commercial impression. See In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) [the mark PLAYERS has different connotations when applied to shoes and to men's underwear]. Thus, we do not think it appropriate under these circumstances to apply the general

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principle that, when the marks in question are identical (or substantially so), their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

We turn next to the du Pont factor focusing on the similarities/dissimilarities of the goods and services. It is well settled that the registrability of applicant's mark must be evaluated on the basis of the recitation of services as set forth in the involved application, compared with the recitation of services and/or the identification of goods contained in the pleaded registrations of record. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Additionally, absent any specific limitations in applicant's identification of goods and the identification of goods and recitation of services contained within opposer's registrations, the issue of likelihood of confusion must be determined by looking at all the usual channels of trade and methods of distribution for the respective services and

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goods. See CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Opposer acknowledges that there are obvious differences between opposer's services and goods and applicant's services. Nonetheless, opposer argues that:

... it is clear that the goods and services are related and that the public will be confused as to the source of the goods or services from Applicant if she is allowed to use the mark for consultation and business planning services in and to the pharmaceutical, software and healthcare industries. Applicant's use of the mark will infringe upon related goods/services produced by Opposer. Applicant has marketed herself to pharmaceutical and software industries for assistance in the creation of wireless networks and has indicated plans to expand to related goods/services including consultation and assistance in the fields of electronic data capture. This electronic data capture software and related services are precisely the goods and services Opposer markets to the public.

Opposer's brief, pp. 16 - 17.

Opposer is correct in noting that goods and services need not be identical in order to support a finding of likelihood of confusion. On the other hand, opposer has the burden of proof in this proceeding to demonstrate a relatedness of the services and/or goods, as well as to show an overlap of customers and institutions.

Based on the limited record before us, we cannot determine exactly who opposer's customers are. Although by

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the very identifications of opposer's goods and services, it is obvious that they are used in connection with clinical trials of pharmaceutical products, it is not clear whether these goods and services would be sold or offered to hospitals or other health care facilities, or whether they would be purchased only by pharmaceutical companies whose products are being tested, such that the entities actually carrying out the trials would not encounter opposer's mark. Thus, even though we must construe applicant's identified consultation services as encompassing consultation services rendered to those in the healthcare field (a supposition confirmed by the evidence showing that applicant is interested in teaming up with a consultancy firm to equip healthcare facilities with wireless infrastructures allowing for tasks such as electronic data capture (Adams Deposition, pp. 79 - 101)), we cannot find, based on this limited record, that there is an overlap between opposer's and applicant's customers. Moreover, even if we were to assume that opposer and applicant could offer their respective goods and services to healthcare facilities such as large research hospitals, we cannot determine, from this limited record, that the individual consumers within such large institutions would be the same. For example, pharmaceutical companies may purchase and then supply to those doctors

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carrying out clinical tests the specific software that they purchase from opposer, while others in the administration area of the hospital would encounter applicant's consultation services. See Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) [The Court found no likelihood of confusion resulting from the contemporaneous use of applicant's mark E.D.S. and opposer's mark EDS despite the fact that "the two parties conduct business not only in the same fields but also with some of the same companies." 21 USPQ2d at 1391]; see also In re N.A.D. Inc., 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985). We cannot base a finding of relatedness of services and/or goods on mere speculation, and on this record, find that opposer has failed to show that opposer's goods and services and applicant's consultation services are related. Thus, this key du Pont factor favors applicant.

We turn then to the du Pont factor focusing on the conditions under which and buyers to whom sales are made. Given the respective recitations of services and identification of goods, by definition, opposer's services and goods and applicant's services are not purchased casually by ordinary consumers. Such purchasers, even if they were to encounter both parties' services and goods, are not likely to believe that all goods and services that are

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offered in the healthcare area emanate from a single source simply because they are sold or rendered under the same mark. This du Pont factor clearly favors applicant.

Opposer has not submitted any evidence on the factor of the fame of opposer's marks or the factor of the variety of services and goods on which opposer's mark is used, and therefore we find these factors to be neutral.

In conclusion, although the parties have similar marks, we find, based on this record, that opposer has failed to prove that applicant's services are sufficiently related to opposer's goods and services that confusion is likely. When we consider all the du Pont factors on which there is evidence, we find that opposer has not shown by a preponderance of the evidence that confusion is likely. Accordingly, we dismiss the opposition on the ground of likelihood of confusion.

• Dilution

In addition to its claim of likelihood of confusion, opposer has also pressed a claim of dilution. The Federal Trademark Dilution Act (FTDA) provides a federal cause of action for the dilution of a famous mark, and the Trademark Amendments Act of 1999 (TAA) "requires the Board to consider

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dilution under the FTDA as a ground for opposition."⁵ Toro Co. v. ToroHead Inc., 61 USPQ2d 1164 (TTAB 2001). To prevail on its dilution claim, opposer must establish, *inter alia*, that its mark is famous. Furthermore, establishing fame for dilution purposes is a more rigorous endeavor than establishing the renown of a mark for a Section 2(d) likelihood of confusion analysis. Toro, 61 USPQ2d at 1180-81. Accordingly, having found *supra* that opposer's PHASE FORWARD marks have not been shown to be well-known in the context of our likelihood of confusion analysis, and, in fact, that opposer submitted absolutely no evidence of fame, they are *ipso facto* not famous for purposes of dilution. Accordingly, we dismiss the opposition on the ground of dilution.

Decision: We dismiss the opposition on the grounds of likelihood of confusion and dilution.

⁵ The FTDA, 109 Stat. 985, is codified at Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), with dilution defined in Section 45, 15 U.S.C. §1127, and the TAA, 113 Stat. 218, is codified in various sections of Title 15 of the U.S. Code.